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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,549	11/27/2000	Brian Doege	23969-P001US	7916

7590 10/09/2002
Winstead Sechrest & Minick P.C.
Suite 800
100 Congress Avenue
Austin, TX 78701

EXAMINER

BARRY, CHESTER T

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/723,549	DOEGE ET AL.	
	Examiner	Art Unit	
	Chester T. Barry	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5,8-20,27,28,39 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,8-20,27,28,39 and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Nomenclature

Applicants refer to Biological Systems, Inc. as the "Applicant." To my knowledge, inventors are applicants, not assignees.

Request Regarding Manner of Making Amendments

Applicant is requested, but by no means required, in the future not to precede the amendment of *each* claim with an instruction to enter the amendment to that particular claim. For example, at page 2 of the response filed 8/19/02, applicant wrote:

(3) Please amend Claim 4 as follows:

4. (Twice amended) The method of claim . . . [etc.]

(4) Please amend Claim 5 as follows:

5. (Twice amended) A method for treating . . . [etc.]

In the course of entering these amendments, it is necessary for the examiner's clerk to bracket out the prefatory instruction to enter the amendment lest such remarks inadvertently be printed by the printer should the amended claim issue in a patent. In

this case, in which 19 claims were either amended or added, such bracketing adds little value to the patent examination process and only increases the chances of clerical or printing error, thereby potentially necessitating the filing of a certificate of correction.

The examiner suggests that applicant make one request that certain claim amendments be entered, or that certain new claims be entered. For example, the relevant portion of the 8/19/02 response might have been presented as:

IN THE CLAIMS

Please delete claims 35 – 38 and 40- 41.

Please amend claims 3 - 5, 8, 11 - 13, 18, 19, 27, 28, 39,^[1] and 42 as follows:

3. (Twice amended) A method for . . .

...

42. (Amended) A method for . . .

. . . and the flushing liquid.

Please add new claims 43 – 48 as set forth below:

43. (New) The method . . .

...

48. (New) The method . . . is a trip basis.

¹ Incidentally, applicant erroneously requested that claim 39, which had previously been submitted, be "add[ed]" rather than amended.

Claim Chart

To facilitate further prosecution, the following claim chart is provided:²

3 method

4

5 method

8 method

9

10

11

12

13

17

14

15

16

18 method

19

20

27 method

28 method

39 apparatus

42 method

43

44 method

45

46

47

48

Clarification of Remarks

Assignee stated in Ref. ANA that many of the company's products are "patented or patents pending."³ The examiner requires no further explanation of the "patents pending" remark in light of the existence of this application. The examiner requests –

² Indented claims depend from next-preceding out-dented claim. Claims labeled "method" or "apparatus" in bold are independent claims.

³ Second page, left column, immediately above the photo.

but does not require – that applicant identify the patent or patents believed by them to cover any of their products.

The Declarations filed under 37 CFR 1.131

The declarations filed under 37 CFR 1.131 are unpersuasive for they do not prove the fact of reduction to practice of anything, not to mention reduction to practice of any pending claim. Applicants' declarations are not supported by a sufficient showing of facts upon which to conclude that a reduction to practice of the claimed invention took place. Three of the declarants made only naked assertions of an actual reduction to practice without any supporting documentation at all. The only "evidence" of any kind that was submitted, namely, co-applicant Doege's telephone record, does not support the allegation of reduction to practice of any claimed invention. The query, "Can we fix [Amtrak's odor and disposal problem]?" merely evidences the recognition of a problem, not a working solution of the problem. Similarly, Doege's query, "can we use active bacteria?" restates the problem. It does not stand as evidence of a reduction to practice. As for exhibit D, first, it is unclear whether "Beech Grove" relates to the Beech Grove, Indiana, AMTRAK maintenance facility,⁴ or the Beech Grove business car, e.g., car 10001.⁵ It is unclear if the Beech Grove railroad car is even equipped with a recirculating toilet. It is unclear how the Beech Grove personnel's satisfaction with the product indicates a reduction to practice, because it was only after their expression of

⁴ <http://www.railnews.com/NEWS/IN/020211amtrak.htm>

⁵ <http://www.railroadpix.com/rrphotos/detail/418.html>

such which prompted applicants to run a “test” of the MTC-2000 product. The apparent belief held by Doege of the need for a “test” contraindicates any actual reduction to practice. The manner by which Beech Grove was pleased has not been adequately fleshed out. The remark, “see if they like results,” does not evidence a reduction to practice.

Moreover, there is no evidence supporting each declarant's **verified** statement⁶ that the invention was reduced to practice in an airplane toilet system or in a bus toilet system. The question is, “where's the bus?” And “where's the plane?” Further, there is no evidence of the monitoring step of claim 44, for example.

Nevertheless, Tobey is dropped as a relied-upon reference because it fails to teach or suggest recirculating a flushing fluid.

For a discussion of Rule 131 practice, please see MPEP §715.

Incidentally, from a strategic point of view, it is unclear why applicants were motivated to file the Rule 131 declarations at all: In the interview summary mailed July 24, 2002, the Examiner had already conceded that Tobey does not describe recirculation of a flushing fluid. Since each of the pending claims is limited by the step of recirculating a flushing fluid, or by a recirculation type toilet tank system, there does not appear to have been a need to file verified statements “swearing behind” the May 9, 2000, date.

⁶ To wit, “. . . willful false statements . . .” *etc.*

35 USC §102(g)

Claims 3 – 5, 8-20, 27-28, 39, 42 – 48 are rejected under 35 USC. § 102(g)

Applicants' declarations under 37 CFR 1.131 establishing that it was not Applicants who reduced to practice the invention before May 9, 2000, but rather it was AMTRAK personnel at Beech Grove, Indiana, and/or Metro North personnel who did so at a time before applicants' constructive date of invention, namely, 11/27/00. The Rule 131 declarations do not show diligence from a time before AMTRAK's actual reduction to practice until applicants' constructive reduction to practice when this application was filed on 11/27/2000. There is no evidence that AMTRAK has suppressed, concealed, or abandoned the invention. In fact, Applicants' declarations support AMTRAK's continuing interest in pursuing the invention.

35 USC §102(b)

Claims 3 – 5, 8-20, 27-28, 39, 42 – 48 are rejected under 35 USC. § 102(b) for having offered for sale the invention more than one year before applicants filed this patent application. Applicant Doege's declaration under 37 CFR 1.132 establishes that prior to May 9, 2000, AMTRAK and Metro North stated that "they were under long term contracts with their current suppliers for treatments of their recirculation tank toilet systems." This statement made by AMTRAK and Metro North to Biological Solutions, Inc., is itself substantial evidence that the statement was made in response to an offer to sell the claimed invention to AMTRAK and/or Metro North. Liberally paraphrasing

the relevant parties to illustrate my point, it appears that the conversation might have gone something like this:

Bio.Solutions:	So, do you like our product?
AMTRAK / MetroNorth:	Yes.
BioSolutions:	Good!
	So how about buying some of it for your recirculating toilets?
AMTRAK / MetroNorth:	No, sorry, but we're under long term contracts with our current suppliers for treatments of our recirculation tank toilet systems. Maybe later, when these contracts expire and we put out an RFP.
BioSolutions:	OK, we'll contact you again later.

Accordingly, all of applicants' claims to the invention are rejected for anticipation by the on-sale bar. There does not appear to be any reasonable possibility that the offer of sale occurred before the invention was ready for patenting, because the mission statement of the assignee is, "Never let our marketing exceed our science" TM (Ref. ANA page 2). The mission statement implies that the sale force does not offer for sale products that haven't been proven out first by the "head office research staff."

It is certain that the product offered to AMTRAK and/or Metro North embodied each claimed feature of these rejected claims because each Rule 131 declarant stated – in a verified statement subject to penalties of perjury and the like – that it was the claimed invention of claims "3 – 5, 8-20, 27-28, 39, and 42 – 48." Doege's telephone log substantiates the assertion that it was AMTRAK and Metro North (not applicants) who actually reduced the invention to practice before applicants' constructive date of invention.

The Information Disclosed in the January '02 IDS

Applicants are encouraged to disclose prior public uses and sales of material products, e.g., BMET-7, earlier during prosecution. Applicants have already received two Office actions. Much of the examiner's time was spent finding bacteria in combination with a surfactant. These are now admitted as old. The efficient administration of Title 35 begs of more candor sooner. The examiner did not apply the APA reference in either the March 02 or July 02 Office action because it did not appear to be prior art. The significance of the prior sales of BMET-7 in connection with the claimed invention cannot be underestimated. See below.

35 U.S.C. Sec. 103(a)

Claims 3 – 5, 8-20, 27-28, 39, 42 – 48 are rejected under 35 USC. § 103(a) for obviousness over the BMET-7 and/or BMTB-2010 prior art sales and use in septic tanks, and Sloan's suggestion to recirculate the contents of a septic tank in the course of cleaning it out. A septic tank is a part of a toilet tank system.

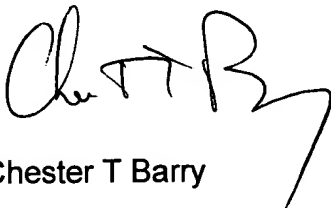
THIS ACTION IS MADE FINAL

Applicants' response necessitated the new ground(s) of rejection presented in this Office action. Specifically, the belated admission that the BMET-7 and BMTB-2010 products were prior art, and the information that AMTRAK and/or Metro North personnel first reduced the invention to practice, not Applicants. Accordingly, **THIS ACTION IS**

MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Respectfully,

A handwritten signature in black ink, appearing to read 'Chester T Barry', with a stylized flourish extending from the end.

Chester T Barry

703-306-5921

10/3/02